

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Patrick Young et al.
Application No. : 10/616,137
Confirmation No. : 2089
Filed : July 9, 2003
For : USER INTERFACE FOR TELEVISION
SCHEDULE SYSTEM
Art Unit : 2621
Examiner : Robert Chevalier

New York, New York 10036
July 7, 2008

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Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Sir:

The above-identified application claims priority to U.S. Patent Application No. 09/277,703 filed March 26, 1999, which issued as U.S. Patent 6,498,895 ("the '895 patent"). The '895 patent was the subject of litigation in Gemstar-TV Guide International, Inc. et al. v. Digeo, Inc. et al., Civ. Action No. 06-6519-DSF in the United States District Court for the Central District of California. This litigation settled on April 22, 2008. In that litigation, the defendants alleged the following with respect to invalidity and unenforceability of the '895 patent, which allegations are disputed by the plaintiffs and are no longer pending as they were settled on April 22, 2008:

1. That Young et al. U.S. Patent 4,706,121 (already of record in this application) constitutes invalidating prior art to the '895 patent under 35 U.S.C. § 102 and/or 103.

2. That all of the claims of the '895 patent are invalid for failure to satisfy the written description and/or enablement requirements of 35 U.S.C. § 112.

3. That the '895 patent is unenforceable due to inequitable conduct based on alleged failure to disclose material information and prior art to the Patent Office during prosecution of the application for the '895 patent. With respect to prior art, the defendants asserted that plaintiffs failed to disclose an alleged prior art system referred to as an "EZ Guide program guide" and information relating thereto. It is believed that PCT Publication No. 89/03085, already of record in this application, is related to EZ Guide. However, the defendants allegation was based on other information concerning "EZ Guide" (including the alleged "EZ Guide" program guide itself), which the defendants also alleged creates a prima facie case of invalidity (including anticipation of asserted claims) of the '895 patent.

The defendants also included as a basis for their allegation of inequitable conduct that the plaintiffs failed to disclose during prosecution of the application for the '895 patent, a prior investigation by the International Trade Commission (In the Matter of Certain Set-Top Boxes and Components Thereof, ITC Investigation No. 337-TA-454 ("ITC")) and a prior litigation (In re Gemstar Development Corporation Patent Litigation, MDL-1274-WBH (N.D. Ga.) ("MDL")) in which the validity and enforceability of U.S. patents 5,479,268 ("the '268

patent") and 5,809,204 ("the '204 patent") were challenged (this application, the '204 patent, and the '895 patent all claim priority to the application that issued as the '268 patent). A copy of the ITC decision (version redacted by the ITC to remove confidential information) and an opinion of the U.S. Court of Appeals for the Federal Circuit concerning that decision are submitted herewith.

Defendants also asserted in connection with their allegation of inequitable conduct that the plaintiffs failed to disclose from those prior proceedings: (i) pleadings, discovery responses, expert reports, testimony and briefs that challenge the validity of the '268 and '204 patents; (ii) claim construction positions with regard to claim terms that overlap between the '268 and '204 patents and the '895 patent; (iii) allegations of unenforceability based on patent misuse based on alleged improper licensing practices (and pleadings, expert reports, and testimony concerning those allegations, and determinations of patent misuse by the ITC Staff and the ITC Administrative Law Judge), which licenses defendants allege would cover the application that issued as the '895 patent and the '895 patent itself.

4. That the '895 patent is unenforceable due to patent misuse based on alleged improper licensing practices.

It is submitted that the subject matter being pursued in the claims of this application is substantially different than the subject matters claimed in the '268, '204 and '895 patents.¹ Thus, none of the allegations

¹ The '268, '204 and '895 patents are cited for the Examiner's consideration in the accompanying PTO/SB/08.

discussed above is believed to be relevant to the claims of this application, and therefore, the parties' pleadings, submissions and other materials from those proceedings have not been provided. In addition, it is submitted that the misuse allegations are irrelevant in any event because misuse is not material to patentability of claims. Indeed, even if a patent is held in litigation to be unenforceable due to misuse, misuse may be purged. U.S. Gypsum Co. v. National Gypsum Co., 352 U.S. 457, 465 (1957).

While it is believed that none of these issues is relevant to the patentability of the subject matter of the claims being pursued in this application, the issues are presented herein out of an abundance of caution because they have been raised by a third party in connection with pending litigation involving the '895 patent. Applicants will promptly provide additional information concerning the pending and prior proceedings should the Examiner request it.

The following documents, which are listed on the accompanying Form PTO/SB/08, have come to applicants' attention as part of the ITC investigation:

CA 1217269	01-27-1987	Sony Corp.
4,488,179	12-11-1984	Eckhard et al.
EP 300562	01-25-1989	Philips Electronics UK Ltd.

The following documents, which are also listed on the accompanying Form PTO/SB/08, were prepared in connection with the MDL litigation:

"Expert Report of Dr. Gary S. Tjaden," May 13, 2002.
"Expert Report of Dr. Gary S. Tjaden," December 18, 2002.

"Expert Report of Stephen D. Bristow with regard to validity of U.S. Patent Nos. 5,568,272 and 5,508,815," June 10, 2002.

Applicants would like to draw the Examiner's attention to pages 35-37 of the Bristow Expert report which address U.S. Patent No. 5,568,272, issued on U.S. Application No. 08/546,335, from which U.S. Patent No. 5,915,068 ("the '068 patent"), issued on U.S. Application No. 08/731,401 claims priority. The '068 patent was subject to a March 29, 2007 Office Action mailed in the above-identified application and applicants' September 28, 2007 Reply to Office Action.

The remaining documents listed on the accompanying Form PTO/SB/08 have come to applicants' attention in connection with counterpart proceedings in Japan and Europe.

Copies of the Foreign Patent and Non-Patent Literature documents (listed on the accompanying Form PTO/SB/08) are being submitted herewith.

Consideration of the foregoing in relation to this patent application is respectfully requested.

Respectfully submitted,

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